REMARKS

The present invention is a portable device, a method of operating a portable device and a computer program comprising program instructions for operating a portable device and when loaded on the processor causing the processor to perform the program steps. A portable device in accordance with an embodiment of the invention includes a user input 28 and 36 comprising a key having a first function of performing a shortcut to a predetermined menu when the device is in a first state and a second function when the device is not in the first state; a processor 44 for determining the state of the device and for performing a function in response to a first mode of operation of the key; and wherein the second function is a change of state of the device to the first state and the predetermined menu comprises a list of first level menu items. See the summary of the invention.

Claims 14 – 24, 29 and 31 – 33 stand rejected under 35 USC 103 as being unpatentable over United States Patent No. 5,542,103 (Mottier et al). These grounds of rejections are traversed for the following reasons.

Claim 14 recites "...a user input comprising a key having a first function of performing a shortcut to a predetermined menu when the device is in a first state and a second function when the device is not in the first state ... wherein the second function is a change of state of the device to the first state and the predetermined menu comprises a list of first level menu items"; claim 37 recites "...actuating a user input comprising a key having a first function of performing a shortcut to a predetermined menu when the device is in a first state actuating the user input and when the device is not in the first state, the key having a second function ... wherein the second function of the user input is a change of state of the device to the first

state and the predetermined menu comprises a list of first level menu items"; and claim 38 recites "...detecting actuation of a user input comprising a key having a first function of performing a shortcut to a predetermined menu when the device is in a first state and a second function when the device is not in the first state ... wherein the second function of the user input is a change of the state of the device to the first state and the predetermined menu comprises a list of first level menu items". This subject matter has no counterpart in Mottier et al.

Mottier et al discloses a radio telephone in which a volume key may be actuated twice to display a menu 109. If the volume key is not depressed after the menu is displayed and before the call is answered, the feature of the display is activated when the call is answered. If the volume key is depressed additional times before the call is answered, a different feature from the menu will be selected for each depression of the key. When all of the features of the menu have been selected and the volume key is depressed again, the first feature will again be selected and the list of features repeated for each subsequent depression. See column 2, lines 40 – 56. As may be seen from the aforementioned portions of Mottier et al, Mottier et al, while providing a shortcut to a predetermined menu by pressing the volume key twice, do not disclose the second function of the volume key being a change of state of the device to the first state and the predetermined menu comprises a list of first level menu items. Mottier et al do not suggest that the volume key may be used to return directly to a first state wherein the volume key has a first function of performing a shortcut to a predetermined menu.

Instead, as is apparent from the flow chart of Figure 1 of Mottier et al, when the volume key is depressed twice at decision point 105, the process proceeds to

step 109 and must then pass through the activate feature 112 without the volume key 105 being activated to cause restoring to the first state 101, 102. The aforementioned operation occurs automatically once the user has depressed the volume switch twice which is fundamentally different than the claimed second function of the key of a change of state of the device to the first state.

Claims 25 – 28 stand rejected under 35 USC 103 as being unpatentable over Mottier et al in view of United States Patent 5,966,671 (Mitchell et al). Mitchell et al has been cited as disclosing a device where the processor determines the mode of operation of the key by the duration of operation. However, Mitchell et al's do not cure the deficiencies noted above with respect to Mottier et al. Accordingly, it is submitted that claims 25- 28 are not obvious.

Claim 30 stands rejected under 35 USC 103 as being unpatentable over Mottier et al. Claim 30 is patentable for the same reasons set forth above with respect to claim 14.

Newly submitted claims 35 – 40 define further aspects of the present invention which are not anticipated or rendered obvious by Mottier et al alone or in combination with Mitchell et al. Newly submitted independent claims 37 and 38 are patentable for the reasons set forth above.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli,

Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 1156.41537X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

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